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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,833	04/24/2006	Nels R. Smith	026032-5052	2281
23428 7590 01/22/2009 FOLEY AND LARDNER LLP SUITE 500 3000 K STREET NW WASHINGTON, DC 20007				
EXAMINER				
VO, HAI				
ART UNIT		PAPER NUMBER		
1794				
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01/22/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/576,833

Applicant(s)

SMITH ET AL.

Examiner

Hai Vo

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2008.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-34 is/are pending in the application.
4a) Of the above claim(s) 13-25 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 26-34 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/ISD)
Paper No(s)/Mail Date 04/24/2008
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

Election/Restrictions

1. Applicant's election with traverse of Group II, claims 26-34 in the reply filed on 10/30/2008 is acknowledged. The traversal is on the ground(s) that the Examiner fails to show that (A) the process as claimed is not an obvious process of making the product and the process as claimed can be used to make another materially different product; or (B) that the product as claimed can be made by another materially different process (M.P.E.P. § 806.05(f)). This is not found persuasive because the present application is a national stage application filed under 35 U.S.C. 371, the restriction practice under M.P.E.P. § 806 is irrelevant to national applications. The unity of invention practice under M.P.E.P. § 1800 is applied instead. Accordingly, the inventions listed as Groups I-II do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Claim 26 is anticipated or obvious over US 6,248,200 (see rejections below). As the recited structure does not make a contribution over the prior art, unity of invention is lacking and restriction is appropriate. The requirement is still deemed proper and is therefore made FINAL.
2. Applicants are reminded of their right to request rejoinder of method claims with the product claims upon indication of the product claims as being allowable. The method claims must be commensurate with the allowed article claims, i.e. have been amended to recite all the features of the allowed article claims. See *In re Ochiai* 37 USPQ 2d 1127.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 33 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 33 recites the limitation "the panel" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 26-28, 30, 32 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Kornylo (US 5,387,390). Kornylo discloses a door trim panel assembly comprising: a flexible skin 40 having a flange that extends substantially entirely about the periphery of the skin; a soft foam material 42 coupled to the

skin; a rigid substrate 42 having grooves that define an area; wherein the flange of the skin are coupled to and embedded in the grooves of the substrate which provides a visual boundary defined by the groove and extends substantially entirely about the periphery of the area over which the skin is provided; wherein the soft foam material is located between the skin and the substrate and is configured to provide a first soft region (figure 1). The flange comprises a folded back configuration that forms a protrusion (see a portion of window sill upper portion adjacent to the bolster receiving portion in figure 1). The substrate is injection molded of a polyurethane (column 5, lines 1-5). The skin is a vacuum formed sheet of a vinyl material (column 4, lines 18-19 and 25-30). The soft foam material is polypropylene (column 4, lines 20-25) which is a compressible material. Accordingly, Kornlyo anticipates the claimed subject matter.

8. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kornlyo (US 5,387,390) as applied to claim 1 above, and further in view of Pokorzynski et al (US 2002/0125734). Kornlyo does not specifically disclose the skin layer made from a thermoplastic olefin material. Pokorzynski discloses a component for a vehicle interior comprising: a flexible skin 25 having a flange 30 that extends substantially entirely about the periphery of the skin; a compressible material 35 coupled to the skin; a rigid substrate 8 having grooves 42 that define an area; wherein the flange of the skin are coupled to and embedded in the grooves of the substrate 18 which provides a visual boundary defined by the groove and extends substantially entirely about the periphery of the area over which the skin

is provided; wherein the compressible material is located between the skin and the substrate and is configured to provide a first soft region (figures 1 and 2). The skin is injection molded of TPO (claim 14). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a closed cell foam for the compressible material use the TPO for the skin material because such is an intended use of the material and Pokorzynski provides necessary details to practice the invention of Kornyo.

Kornyo as modified as Pokorzynski does not specifically disclose the skin is vacuum formed. However, it is a product-by-process limitation not as yet shown to produce a patentably distinct article. It is the examiner's position that the resulting skin layer of Kornyo as modified as Pokorzynski is identical to or only slightly different than the claimed article prepared by the method of the claim, because both skin layers are formed from the same materials, having structural similarity as discussed above. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289,291 (Fed. Cir. 1983). It is noted that if the

applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with Kornylo/Pokorzynski.

9. Claims 26 and 28-34 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Pokorzynski et al (US 2002/0125734). Pokorzynski discloses a component for a vehicle interior comprising: a flexible skin 25 having a flange 30 that extends substantially entirely about the periphery of the skin; a compressible material 35 coupled to the skin; a rigid substrate 8 having grooves 42 that define an area; wherein the flange of the skin are coupled to and embedded in the grooves of the substrate 18 which provides a visual boundary defined by the groove and extends substantially entirely about the periphery of the area over which the skin is provided; wherein the compressible material is located between the skin and the substrate and is configured to provide a first soft region (figures 1 and 2). The substrate is injection molded of a polypropylene material (claim 17). The compressible material is a closed cell foam (paragraph 11). The skin is injection molded of TPO (claim 14). The second soft region is defined by a portion of the skin in direct contact with the substrate as shown in figure 2. Pokorzynski does not specifically disclose the skin is vacuum formed. However, it is a product-by-process limitation not as yet shown to produce a patentably distinct article. It is

the examiner's position that the component of Pokorzynski is identical to or only slightly different than the claimed article prepared by the method of the claim, because both articles are formed from the same materials, having structural similarity as discussed above. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289,291 (Fed. Cir. 1983). It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with Pokorzynski. Accordingly, Pokorzynski anticipates or strongly suggests the claimed subject matter.

10. Claims 26-29, and 32-34 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Dailey et al (US 6,248,200). Dailey discloses a door trim panel assembly comprising: a flexible skin 30 having a flange that extends substantially entirely about the periphery of the skin; a compressible material 33 coupled to the skin; a rigid substrate 16

having grooves that define an area; wherein the flange of the skin are coupled to and embedded in the grooves of the substrate 26 which provides a visual boundary defined by the groove and extends substantially entirely about the periphery of the area over which the skin is provided; wherein the compressible material is located between the skin and the substrate and is configured to provide a first soft region (figure 3). The substrate is injection molded of a polyurethane (claim 17). The compressible material and the skin are made of a vinyl material (column 3, lines 3-5). The second soft region is defined by a portion of the skin in direct contact with the substrate as shown in figure 3. The flange comprises a folded back configuration that forms a protrusion (figure 3). The trim panel provides a relatively soft arm rest portion (column 4, lines 1-4). This at least indicates the relatively soft integral arm rest pad must be compressible so as to effectively soft arm rest portion. Dailey does not specifically disclose the skin is vacuum formed. However, it is a product-by-process limitation not as yet shown to produce a patentably distinct article. It is the examiner's position that the component of Dailey is identical to or only slightly different than the claimed article prepared by the method of the claim, because both articles are formed from the same materials, having structural similarity as discussed above. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from

a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289,291 (Fed. Cir. 1983). It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with Dailey. Accordingly, Dailey anticipates or strongly suggests the claimed subject matter.

11. Claims 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dailey et al (US 6,248,200) as applied to claim 1 above, and further in view of Pokorzynski et al (US 2002/0125734). Dailey does not specifically disclose the compressible material made from a closed cell foam. Pokorzynski, however, discloses a component for a vehicle interior comprising: a flexible skin 25 having a flange 30 that extends substantially entirely about the periphery of the skin; a compressible material 35 coupled to the skin; a rigid substrate 8 having grooves 42 that define an area; wherein the flange of the skin are coupled to and embedded in the grooves of the substrate 18 which provides a visual boundary defined by the groove and extends substantially entirely about the periphery of the area over which the skin is provided; wherein the compressible material is located between the skin and the substrate and is configured to provide a first

soft region (figures 1 and 2). The substrate is injection molded of a polypropylene material (claim 17). The compressible material is a closed cell foam (paragraph 11). The skin is injection molded of TPO (claim 14). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a closed cell foam for the compressible material motivated by the desire to provide some measure of support and a soft feel to the trim assembly.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (571) 272-1485. The examiner can normally be reached on Monday through Thursday, from 9:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hai Vo/
Primary Examiner, Art Unit 1794